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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/633,187 12/28/90 CHENARD

J MNTC-0006-B

EXAMINER

HOKE, V

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1300 I STREET, N. W.
WASHINGTON, DC 20005-3315

ART UNIT

PAPER NUMBER

1509

DATE MAILED:

10/18/91

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

Dec. 28, 1990

☒ This application has been examined ☒ Responsive to communication filed on April 17, 1991 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 73-75, 77, 78, 80-84, 87-89, 91, 92-106, 108, 109, 114-118, 121-123, 125, 126,
127-134, 136-141, 143-191, 193-198, 200-207, 209 are pending in the application.
to 217, 219-225, 227-246.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 193-198, 200-207, 209-217, 219-225, 227-233, 237-246 are allowed.
4. ☒ Claims 73-75, 77, 78, 80-84, 87-89, 91-106, 108, 109, 111-118, 121-123, 125, 126, 128-134, 136-
141, 143-191 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☒ been filed in parent application, serial no. 670,503; filed on 8-28-77
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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15.

The preliminary amendments dated December 28, 1990 and April 17, 1991 have been entered.

16.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person ~~shall be~~ entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 80-84, 94-102, 14-118, 128-134 and 143-191 are rejected under 35 U.S.C. § 102(a) as being fully met by each of Japanese Kokai 56-2336 ad Japanese Kokai 55-160,044.

The examiner's rationale as will be explained hereinbelow, is the same as set forth in paragraph 15 of the Office action dated June 26, 1990 in the parent application SN 273,669, filed November 18, 1988, now abandoned. The traversal made in anticipation of this rejection (preliminary amendment dated April 17, 1991 pages 6 thorough 14) is clearly untenable. The claims here are even more broad than those set forth in the grandparent application 254,313 in which the Board of Patent Appeals and Interferences held that the subject matter claimed was unsupported in any of those applications as well as their French

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priority application dated filed. Applicants exhibit "B" at page 4 relates the pertinent portion of said decision as follows:

"The present application, Serial No. 254,313, enlarges the scope of both the mono- or diorganotin derivative and the mercapto ester used to stabilize the polyvinyl halide polymer. In particular, the tin derivative now claimed includes a mono- and diorgano- tetravalent tin derivative where the remaining valences are satisfied by halogen and phosphorus as well as by the removal of the hydrogen atom from the oxygen atom of a carboxylic acid, an alcohol or toluol and the removal of hydrogen atom from the sulfur atom of the mercaptan, mercapto alcohol, mercapto acid or mercapto alcohol ester (see pp. 14-16). And the mercapto ester now includes the addition of optional substituents, as well as the addition of oxygen, carbonyl oxy, nitrogen and sulfur in the linear hydrocarbylene chain. Also, in forming the mercapto ester by reacting an acid with a mercapto alcohol, acid-capped polyethers, acid-capped silicone esters, and amino acids are now disclosed as useful (see pp. 8-13).

From our review of the parent application and the present application, we agree with the examiner that appellants are not entitled to the benefit of the filing date of their parent application for the instant claims on appeal since they define subject matter not disclosed in the parent case. Since appellants cannot claim benefit of the filing date of their parent case, claims 59 through 62 and 64 through 69 are accorded the date of April 15, 1981, the filing date of the instant application, and the Japanese documents and the Kugele patent are available 35 USC 102 references. We are not persuaded by appellants' argument that their French application and parent application disclosures are sufficient to show that appellants were in possession of a generic concept. The term "invention" as used in 35 USC 120 refers to the claimed invention and not a concept." (Emphasis added)

Since applicants were held to not be in possession of a generic concept of a claim having a organotin-sulfur bonded stabilizer and having certain additional tin-ligands specified, e.g. Sn-Cl, it is specious to contend that the instant claims' organotin-sulfur bonded compounds having no additional tin-ligand bonding(s) stated, the tin here being equally tetravalent by

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virtue of the possible diorgano and sulfur stipulations, presents subject matter that applicants earlier US filed applications and French priority application provide an enabling support therefore either.

Office Action Dated October 29, 1989 in SN 273,669

As stated in the examiner's answer in the parent application 254,313 filed April 15, 1981 and appealed to the PTO Board of Patent Appeals and Interferences (paper no. 35 page 5)

"Applicants do not specifically disclose the mono and di-organo tin mercapto acid ester halide of these references. Their claims stipulation however, that the organotin stabilizer can contain a Sn-halide link as well as the Sn-S link derived from reacting an organotin compound with a mercaptan or mercapto acid/ester indicates that such broad language encompasses references' tin stabilizers which are similarly used with mercapto esters.

It is considered that applicants having now presented for the first time in their series of foreign and US applications, specific referral to such organotin mercapto acid ester halides in the instant application which was filed subsequent to the reverence disclosures' publication, rejection as fully anticipated inventions under 35 USC 102 (a) is justified.

The assertion that the 37 CFR 1.131 declaration filed August 13, 1984 established that applicants were in possession of a generic concept encompassing the use of all known organotin

stabilizers prior to the references' publications, is contradicted by the fact that applicant had contended during the grand parent application's prosecution that their organotin component's recitation, which was then couched in the even broader terminology "a metal containing stabilizer", was distinct from Gough's organotin borate. See attached exhibit A, page 2, third paragraph. This traversal was clearly untenable and is so even in this application inasmuch as the organotin stabilizer is specially stated as possibly containing a Sn-O link, and no prohibition that the oxygen be further linked to boron is indicated in either the claims or the disclosure.

Having expressly abandoned the parent application for the purpose of filing this application in order to provide support for the broad tin stabilizer terminology and also ostensibly for purpose of avoiding Gough's organotin borate, Appellants are in no position to assert that they were in possession of a generic concept in using any and all organotin compounds prior to the references' publications, independent of what other species their declarations espoused as having been earlier reduced to practice."

Applicants contended that their earlier foreign applications and parent application relate that they were possession of a generic invention in the organotin-mercapto ester stabilizer concept and that therefore the presence as an added stabilizer of

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an organotin halide such as now set forth on page 21 in the specification of this application would have been appreciated at the time. They relied on the Wowk US Patents and Larkin US Patent attached to Foure's 37 CFR 1.131 affidavit which accompanied the amendment dated December 23, 1923, paper 16, as evidence that organotin mercapto halides per se (Wowk) or organotin halides such as octyltin trichloride in combination with standard tin stabilizers such as butyl tin tri (isooctyl mercapto acetate) (Larkin) were known organotin stabilizers at that time for PVC resins". Their use in lieu of those species found in the French priority applications (di-n-octyltin bis(isooctyl mercapto acetate), a butyl stannic acid/butyl thiostannic acid copolymer, butyl stannic acid and dibutyl tin bis (isooctyl mercapto acetate) is urged by applicants as having been appreciated as obvious equivalents for purposes of use with the mercapto ester.

Contrary to applicants counsels assertion (preliminary amendment and information disclosure statement at page 26), the Foure, Chenard and Mendelsohn declarations under 37 CFR 1.131 were also found wanting by the this Appeal Board (decision dated June 25, 1987 page 6) in removing these references as they were found not to be commensurate with the references' disclosures in the scopes of each of 1) the organotin compounds and 2) the mercapto alkanol derived monocarboxylic acid ester contemplated.

Office Action Dated June 29, 1990 in SN 273,669

Applicants absence of stipulating the possible Sn-halide bonding and absence of stipulating the possible Sn-S(R/COOR) R-OH/RCOOH) bonding in the claims does not obviate the rejection since in the failure to recite the remaining Sn linked moieties (which can be ostensibly be halogen in the first instance and mercapto groups in the second), the organotin mercapto/acid/ester halides of these references dual stabilizer system (organotin plus mercapto alcohol-derived monocarboxylic acid ester) is not precluded by said incomplete organotin compound definitions. Contrary to applicants contention while the above set of claims may be considered narrower in one aspect (Sn-halide bonding as opposed to Sn-O, Sn-P or Sn-S bonding) the failure to recite the remaining moiety's scope, (tetravalent organotin compounds are contemplated), indicates that the references' remaining mercapto radical's presence are not precluded. Therefore the claims are even broader than the claims which they replace (59-62 and 64-69) since there is no stipulation that the remaining radical be a residue resulting from the "removal of a hydrogen atom from the oxygen atom of a carboxylic acid, an alcohol or a polyol" or "removal of the hydrogen from the sulfur atom of a meraptan, mercapto alcohol, mercapto acid ester or mercapto alcohol ester". Since applicant's organotin compound is now even broader, the Board's holding that the Japanese references showed more of the

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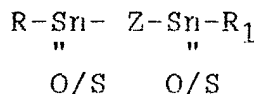
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claimed compound than the affidavit evidence presented is yet a valid basis for concluding that a generic concept was not established by applicants prior to these references publications. 17.

Claims 73-75, 77, 78, 80-81, 87-89, 91, 92-106, 108, 109, 114-118, 121-1232, 125, 126, 128-134, 136-141, 143-191, and 234 to 236 are rejected under 35 U.S.C. § 102(b) as being fully met by Bresser et al (984).

Office Action Dated October 5, 1989 in SN 273,669

This US patent claims the use of a mercapto alkanol derived monocarboxylate and a bis (organotin) compound having the formula



where R and R₁ are each essentially hydrocarbyl and Z is a S,S' linked mono or di carboxylic acid ester radical.

Applicants foreign priority and earlier filed US applications are not seen to provide support for these S,S' carboxylic acid ester linked bis organotin compounds. Applicants species as well as generic formulas (page 15 and 16) do not encompass such compounds since all the compounds on page 16 are only -S- linking - tin - containing while those that do have a S,S' linking carboxylic acid ester group (page 15, line 16) do not contain any Sn = O/S bonding since R⁴ is always hydrocarbyl.

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Office Action Dated June 29, 1990 in SN 273,669

The rejection remains since applicants Sn-linked mercapto acid ester residue definition does not preclude references S,S' linked mono or dicarboxylic acid ester linked Sn compounds.
18.

Claims 73-75, 77, 78, 80-84, 87-89, 91, 92-106, 108, 109, 114-118, 121-123, 125, 126, 128-134, 136-141, 143-191, 234 and 236 are rejected under 35 U.S.C. § 102(a) as being fully met by Kugele et al (114).

Office Action Dated in SN 273,669

Applicants claims are broad enough to encompass the organotin halide and mercapto alkanol derived mercapto acid ester stabilizer system of this references (claim in col. 29 - component "B") for which aspect support is found in this application on page 8 vis - a - vis the G radical is - C⁰ - R³-SH and pages 14-16 for the organotin halide. See col. 15 of the Kugele patent.

Inasmuch as this invention is claimed by Kugele et al it can be obviated only by determining the first inventor through an interference proceeding. Applicant should copy any claim(s) which they believe can be make in order to initiate such proceeding.

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Office Action Dated in SN 273,669

Contrary to applicants counsels assertion these claims broad mercapto alkanol ester of a mono carboxylic acid do not define over those of this reference wherein the acid is a mercapto substituted acid. Monocarboxylic acid is generic thereto. Hydrocarhyl mono-carboxylic would obviate the rejection.

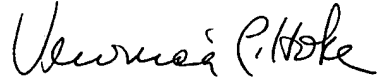
19.

This is a continuation of applicant's earlier application S.N. 273,669. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See M.P.E.P. § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Hoke:ab
October 16, 1991

703 - 308-2351


VERONICA P. HOKE
PRIMARY EXAMINER
ART UNIT 159B